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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/820,292

03/27/2001

Daniel F. Williams

PSTM0042/MRK

1726

29524

7590

05/29/2008

KHORSANDI PATENT LAW GROUP, A.L.C.

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/820,292	Applicant(s) WILLIAMS ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) 22-26,28-61,66-99,104-137 and 142-169 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21,27,62-65,100-103 and 138-141 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080219</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/08 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-10, 19-21, 60-65, and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al. (US 2002/0019777) in view of Siegel (US 2004/01435519), Junger (6,269,344) and Kara (6,233,568).

4. With respect to Claims 1-9, 60-65, and 100-102: Schwab discloses the use of an online merchandise return computer system (see abstract, the examiner considers the online merchandise return computer system to include both the merchant computer, as well as the third party/agent computer, due to the fact that they both computers cooperatively work together, to process and return a product) where the computer system is programmed to:

- a. Receive an indication of shipment of an item and an indication that the item is potentially returnable (see ReturnCert, and Paragraph 0052-0053, the examiner considers the items to be potentially returnable, due to the fact that they have yet to be returned, therefore they are potentially returnable).
- b. Save a set of return rules which is inputted by a merchant (Paragraphs 0052 and 0053) where the rules provides exceptions where a user cannot return item (Paragraph 0071)
- c. Receive an online return request by a consumer (Paragraph 0052);
- d. Determine a set of information about the particular respective item of merchandise (the examiner considers the information gathered from the return questions to be determining a set of information about the item, Parameter request, reference numeral 605, product return parameters, such as description of product and condition of product)

- e. Compare the set of information with the set of return rules (Paragraph 0012 and 0053).
 - f. Schwab discloses the use of a set or return questions (Parameter request, reference numeral 605, product return parameters, such as description of product and condition of product), and processing the return according to the rules (See Paragraphs 0012, and Paragraph 0053).
 - g. Schwab discloses if the item is returnable to provide the user with the Return cert, in which the user can use to deliver the item to the merchant (See Figure 9 with corresponding detailed description, and Paragraphs 0014-0015).
5. Schwab, however, fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item. Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request (See Figure 1A with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab to include the display and interactive means of Siegel, in order to provide a single action return process to reduce the amount of sensitive information transmitted to increase security and ease of use for the customer (See Siegel, Pages 1 and 2).
6. Schwab and Siegal disclose the use of a method for authorizing returns, however Schwab and Siegal disclose the initiation of the return being through a third party website, and fails to disclose it being through the online retail computer system. Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer system for

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authorization of the return (Column 2, lines 46-67). Therefore, with the return processing method of Schwab and Siegal, disclosing the claim limitations of Claim 1. Because both Schwab and Siegal and Junger teach methods for returning purchased items, it would have been obvious to one skilled in the art to substitute one method for the other to achieve the predictable result of returning an item to a retailer. (See *KSR International Co. v. Teleflex Inc.*, 550 US-82 USPQ2d 1385 (2007))

7. Schwab, Siegal and Junger, disclose the use of shipping the return to the manufacturer, but fail to disclose displaying multiple carriers for use by the user to ship the item to the merchant. Kara discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers (See Figure 8, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract). Furthermore all of the method steps are known in Schwab, Siegal, Junger and Kara. The only difference is the combination of “old steps” into one method of returning and allowing the user to choose the carrier. Thus, it would have been obvious to one having ordinary skill in the art to display the carriers to the user as taught by Kara, in the return method of Schwab, Siegal and Junger, since the method of displaying multiple carriers which can be used to ship the return, is used to achieve predictable results of giving the user a choice. (See *KSR* [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

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8. With respect to Claims 10-12, 27, 62-65, 103, and 138-141: See Kara, Figure 8 with corresponding detailed description.
9. With respect to Claims 19 and 20: Siegel discloses the use of an online merchandise return system, which prints shipping labels for returns (See abstract).
10. With respect to Claim 21: See Siegel, Figure 1A, and Figure 5 with corresponding detailed descriptions
11. Claims 13-21, 27, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab, Siegel, Junger and Kara as applied to claim 11 above, and further in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com) and Barnett et al. (6,369,840).
12. With respect to Claims 13-16, 27, and 65: Schwab and Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Kara, Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time.

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Barnet discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

13. With respect to Claim 17: See Schwab, return transaction 619.

14. With respect to Claim 18: See Kara, Figure 9.

Response to Arguments

15. Applicant's arguments with respect to claims 1-21, 27, 62-65, 100-103, 138-141 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629